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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,525	05/01/2001	Ming Fai Chan	NB-2016.00	4026

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EXAMINER
BERCH, MARK L

ART UNIT	PAPER NUMBER
1624	

DATE MAILED: 07/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/847,525	CHAN ET AL.	
	Examiner	Art Unit	
	Mark L. Berch	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-73* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,24,25,27-32,39-59 and 73* is/are rejected.

7)☒ Claim(s) *10-23,26,33-38 and 60-72* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3,11* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 24-25, 27-32, 39-59 and 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The 7th choice for X is in error. There is no such thing as a divalent PO_2 group. For whatever choice is made, applicants must show that one of ordinary skill in the art would have known that this choice, and not some other, was intended. This choice is no better than the previous one.
2. Several R1 choices are molecules have no valence, i.e. the amines including THAM, and PEG. Thus, e.g. methylamine is a molecule. Correct would be methyl amino or methylammonium, depending on what was intended. The traverse is unpersuasive. Applicants state, " ...these molecules as moieties having a free valence..." That is self-contradictory. A molecule by its very nature has no free valence. Methyl amine is a molecule and as such has no free valence. It could be that applicants intended methyl amino or perhaps methylammonium; there is no way of knowing.

3. Claim 44 is improperly dependent on claim 41. This covers everything. There are no other possibilities. Likewise Claim 47 and 52. The traverse is unpersuasive; it appears to have nothing to do with the actual ground of rejection. Applicants give definitions for the various terms which appear in e.g. claim 44, but that is not the problem. Claim 44 covers everything in claim 41; there are no other possibilities, and hence claim 44 is improperly dependent on claim 41. If applicants disagree, they are invited to set forth an organism which they assert falls in claim 41 but which they assert does not fall into any of the categories of claim 44.
4. Claim 54 does not make sense. It describes a three step process to screen for an antibacterial agent. However, after one has done the first step, the screening is actually complete. Once you have determined e.g. that the test compound has or has not the ability to inhibit the growth, you have already done the screening. What purpose do the second and third steps provide? It appears that something is missing from the claim, because doing the second and third steps add nothing. The traverse does not get to the problem. The preamble calls for screening. That was already accomplished in the first step. The comparison to the compounds of the invention is not set forth in the preamble and is not required by it. That is, regardless of how the comparison of step three results, or even whether any result is obtained, there has already been done the screening. This can be fixed by making the claim a method of comparing, which is what the steps are actually directed to.
5. The dotted line in the claim 59 structure needs to be defined. The traverse is unpersuasive. Dotted lines can mean different things. In this case, there are two plausible readings a) there is a double bond in one of the two positions b) there is an

optional double bond, which can be in either of the two positions. That is, dashed lines can be used, and have been used for two different purposes: optionality of position, and optionality of presence.

6. The third R choice in claim 59 is impossible; it is divalent, but R is required to be monovalent. It is clearly misdrawn. This claim was not amended.
7. Claim 73 seems garbled. The first step is starting material "reacting" with triclosan (2,4,4'-Trichloro-2'-hydroxydiphenyl ether or 5-Chloro-2-(2,4-dichlorophenoxy) phenol). That alone should give the final product. Thus, it is not clear what b) and c) are doing. What is the amount in c) effective for? The reaction is already done. The traverse is unpersuasive. Applicants state that the further steps are to remove the protecting group, the CPh_2. This is mistaken. This group, the benzhydryl group, remains present and is not removed. See the lower right of the formula, and the "diphenylmethyl" at page 92, line 4.

Claims 1-2, 39-58 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The new PO_2 group and SO_2 groups are clearly new matter. Applicants present no evidence that one of ordinary skill in the art would have understood that it was the PO_2 group which was actually intended, as opposed to the e.g. PCl_3 or the $P(OH)_3$ group. As for the other, there is no obvious error, since the SO_3 group is divalent. Moreover, even if it were in error, there is no way of knowing whether the SO_2 group or the SO group would have been intended.

Claim Objections

Claims 10-23, 26, 33-38, 60-72 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Information Disclosure Statement

The examiner notes that applicants have provided the Hasko reference and a 1449B form for this, along with a PCT-ISR for this. Please note that the ISR was for PCT/US01/43566, which is unrelated to this application.

The two references previously struck are indicated on the attached PTO-892.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.

Mark L. Berch
Primary Examiner
Art Unit 1624

November 7, 2002